

REMARKS**Summary of the Office Action**

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1 and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,632,290 to *Green et al.* (“*Green*”).

Claims 1, 3, and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP-63150169 (“JP’169”).

Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *JP’169*.

Summary of the Response to the Office Action

Applicants have cancelled claims 6 and 7, without prejudice or disclaimer. Applicants have amended claim 1 to include the features of canceled claims 6 and 7. No new matter has been introduced. Accordingly, claims 1-5 are presently pending.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement on April 27, 2005. Applicants thank the Examiner for acknowledging the Information Disclosure Statement by initialing the PTO 1449 form and retuning a copy to Applicants.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants have amended claim 1 in order to expedite the prosecution of this case.

Applicants respectfully submit that the amendments to claim 1 do not narrow the intended scope of the claim, and therefore, Applicants do not intend to relinquish any subject matter by these amendments. Applicants respectfully submit that claims 1-5 meet all the requirements of 35 U.S.C. § 112, as amended. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Office Action is Deficient

MPEP § 706.02(j) requires that an Examiner provide the relevant teachings of the prior art relied upon; the difference or differences in the claim over the applied references of record; the proposed modification of the applied references of record to arrive at the claimed subject matter; and an explanation why one of ordinary skill in the art, at the time the invention was made, would have been motivated to make the proposed modification.

Applicants respectfully submit that the Office Action fails to meet the above requirement in that the Office Action merely restates or paraphrases the claim language and then cites generally to the references of record. No attempt has been made to differentiate or compare the claims with the applied references of record. No figures are identified or citations made to the specifications of the applied references of record.

In responding to the Office Action, Applicants merely point out features not found in the applied references of record.

All Claims Comply With 35 U.S.C. § 102(b)

Claims 1 and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,632,290 to *Green et al.* (“*Green*”). Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Green* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 1 recites, in part, "wherein each of the plurality of the projected lines comprises a pointed edge on a top of the each of the plurality of the projected lines; and a tip end of the staple leg simultaneously engages with at least two of the pointed edges." At least these features are not found in *Green*.

The Office Action fails to identify the specific features in *Green* that allegedly equate to the claimed features of the present invention. See the short paragraph discussing *Green* on page 2 of the Office Action. *Green* discloses an anvil for crimping generally U-shaped surgical staples in a surgical stapler. Applicants respectfully submit that *Green* does not disclose, teach, or suggest at least the above-mentioned features of the present invention. Accordingly, the rejection of claims 1 and 5 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Green* does not teach or suggest each feature of newly amended independent claim 1.

Additionally, Applicants respectfully submit that dependent claim 5 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1, 3, and 5-7 stand rejected under 35 U.S.C § 102(b) as being anticipated by JP-63150169 ("JP'169"). Applicants respectfully traverse the rejection for at least the following

reasons.

Applicants respectfully submit that the Office Action has not established that *JP'169* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 1 recites, in part, "wherein each of the plurality of the projected lines comprises a pointed edge on a top of the each of the plurality of the projected lines; and a tip end of the staple leg simultaneously engages with at least two of the pointed edges." At least these features are not found in *JP'169*.

The Office Action fails to identify many of the specific features in *JP'169* that allegedly equate to the claimed features of the present invention, and the particular figure in which these features are found. See the short paragraph discussing *JP'169* on page 2-3 in the Office Action. *JP'169* discloses a stapler with a movable clincher, but the "plurality of the projected lines" feature is not clearly identified. A figure number is not identified and it cannot be determined if the "plurality of projected lines" engages the staple leg and inwardly guides it. Further, there appears to be no "projected lines being formed in parallel with one another; wherein each of the plurality of the projected lines comprises a pointed edge on a top of the each of the plurality of the projected lines," as recited in claim 1. A number of recited features appear to be missing from *JP'169*. Applicants respectfully submit that *JP'169* does not disclose, teach, or suggest at least the above-mentioned features of the present invention. Accordingly, the rejection of claims 1, 3, and 5 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the

rejection under 35 U.S.C. § 102(b) should be withdrawn because *JP'169* does not teach or suggest each feature of newly amended independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 3 and 5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Claims Comply With 35 U.S.C. § 103(a)

Claims 2 and 4 stand rejected under 35 U.S.C § 103(a) as allegedly being unpatentable over *JP'169*. Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *JP'169* fails to teach or suggest all the recited features of newly amended independent claim 1. Claim 1 recites, in part, “wherein each of the plurality of the projected lines comprises a pointed edge on a top of the each of the plurality of the projected lines; and a tip end of the staple leg simultaneously engages with at least two of the pointed edges.” *JP'169* fails to teach or suggest at least these features of claim 1 as demonstrated above.

In rejecting dependent claims 2 and 4, the Office Action states that “*JP'169* lacks the parallel projections being located on the inclined faces,” but asserts it would have been obvious to one of skill in the art to add these features. See the bottom of page 3 in the Office Action.

Applicants request that the Examiner provide a specific citation to the prior art that discloses the above-mentioned features.

Nevertheless, as demonstrated above, *JP'169* fails to teach or suggest all the features of claim 1. As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *JP'169* fails to teach or suggest fail to teach or suggest each feature of independent claim 1, the rejection of claims 2 and 4, which depend from independent claim 1, should be withdrawn. Accordingly, claims 2 and 4 are also allowable because of the additional features they recite and the reasons stated above.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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